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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/621,631	03/26/1996	PATRICK M. BROWN	621.631	1235

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

08/621,631

Applicant(s)

BROWN ET AL.

Examiner

Edward A. Miller

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3641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 07 October 2002 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☒ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See next page.

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1. The brief includes a statement that claims in two specified groups within those groups do stand or fall together, but that the two groups do not stand or fall together, but the brief fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206. This includes that there are no arguments that refer to the specific steps as claimed in the claims in the separate groups. Note the requirement of the rule, as follows:

(7) Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

2. The brief does not contain arguments of the appellant with respect to each of the issues presented for review in 37 CFR 1.192(c)(6), and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR 1.192(c)(8).

a. The brief does not contain, for each rejection under 35 U.S.C. 102, an argument which specifies the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

b. The brief does not contain, for each rejection under 35 U.S.C. 103, an argument which specifies the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection, and an explanation how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument must explain

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why the references, taken as a whole do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not be properly combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(8)(iv).

3. As to the rejection under 35 USC 102, the Harbuck et al. rejection can only be under 35 USC 102(b), as it is not a patent. As to Carlson '970, this patent issued after appellants' filing date, and thus the rejection is under 35 USC 102(e), as applied.

4. In the arguments for claim 10 as to Carlson '970, appellants make a general allegation, but fail to point to any specific limitation in claim 10 which is not shown in the reference. For example, note the allegation regarding "concurrent separation" on page 6, just over half way down, of the brief. Appellants have not pointed to any limitation in claim 10 that precludes "concurrent", or conversely requires "sole". Of course, this is for good cause, as the claims and specification clearly teach such concurrent processing at various stages, and the claims are all of the broad, "comprising" scope. [See MPEP 2111.03.] Further, the argument of appellants bridging pages 6-7 of the brief, has nothing to do with any limitation claimed in claim 10, the sole claim at issue, or if it does, appellants have not pointed out the claim limitation that requires such. Clearly, this constitutes defects in the arguments of appellants.

5. In the arguments for claim 10 as to Harbuck, only general, or improper, allegations are found. Appellants are reminded of their duty of candor before the office. In the rejection, the examiner pointed to specific portions of Harbuck, including pages 109, e.g. As to appellants' arguments, the question of obviousness, e.g., is viewed as by the hypothetical person of ordinary skill in the art, as Judge Rich pointed out in *In re Sovish*, 226 USPQ 771, not the absence of ordinary

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skill. In this endeavor, appellants are expected to read the references cited, and understand the technology. At about the 6th line from the bottom, on page 7 of the brief, appellants state that “Harbuck fails to disclose a process for selectively extracting scandium ...” Viewing the first sentence of the last paragraph on page 109, one finds “Solvent extraction test work to selectively recover scandium from the water leach filtrate....” The statement by appellants is not one that could reasonably be made in candor before the Office. Further, it is certainly material, and it cannot be understood how appellants could make such a statement, in view of the clear teachings of the reference. The same problems set forth in paragraph 4 are found herein, that the claims limitations and the specific teachings of the prior art are not compared, in favor of general allegations that are clearly lacking and defective, under the rule.

6. In respect of the arguments as to claim 10 alone for obviousness, the same lack of discussing the actual limitations of the claims compared to the teachings of the references is found. Thus, appellants’ arguments of “simultaneous extraction” of “multiple values” on page 7 of the brief, at lines 5-17, fails to set forth any limitation in claim 10 that would preclude such. Further, the allegation of “teaching away” is especially defective, as appellants also teach simultaneous extraction in the specification in various parts of the method, and due to the “comprising” scope of the claim, which clearly permits such additional aspects of the invention which are permitted by the scope of “comprising” in claim 10. The examiner wonders how the appellants by their attorney can make such material statements on the record that are clearly grossly negligent of basic patent law concepts, as well as the science of the invention as taught in the prior art and the instant specification.

7. As to the rejection of claims 3 and 10-22 for obviousness over Carlson ‘970, the only time the claims are mentioned, they are mentioned as that group. Thus, there are no arguments as to any

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limitations set forth in claims 14, 21, 3, and 22, which serve to argue why the claims of this allegedly separate group are separately patentable, as required by the rule.

8. Further, as to the defect in arguments for the rejection under 35 USC 103, the continued reference to portions of the specification, instead of limitations in the claims, in the arguments fails to specify how the claims define over the teachings of the prior art. Next, to refer, as appellants do on page 8, in the last 8 lines, to, "...either in the references themselves or ... to combine the reference teachings," is not understood. The rejection is over one single reference. Thus, case law as to combining a plurality of references is clearly defective argument, as the rejection makes no suggestion to combine any references; there is but one reference! Within the single reference, there are a number of scenarios that are comprehensively set forth. In view of the "comprising" scope of the claims, the argument cannot be understood. If appellants are again making allegations of plurality of metals, when such are permitted by the scope of the claims and taught in the specification, such amounts to defects in the arguments. At no point in the brief, do appellants point to a single specific limitation of any claim, such as claim 10, which is not taught or suggested by the (sole) reference. Such general allegations do not satisfy the requirement of the rule:

8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

...

iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

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[Emphasis added, above.] In no place, is any specific claim limitation discussed or compared to the prior art. General allegations fail to satisfy the requirement of the rule.

9. Appellants are further advised that, in September, 2004 [this examiner has not yet had training as to details, e.g., the specific requirements or effective date], the practice of the Office, as to Appeal Briefs will be changed. On a cautionary note, should appellants file their amended brief after the effective date of such changes, yet another amended brief will be required to comply with the new rules that will go into effect on that date.


10. Appellant is required to comply with provisions of 37 CFR 1.192(c).

To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

11. Any inquiry concerning this or earlier communications from the examiner should be directed to the examiner's supervisor, Michael Carone on (703) 306-4198.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miller/em
August 27, 2004


EDWARD A. MILLER
PRIMARY EXAMINER